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Supreme Court of the United States

October Term, 1950

No. 570

MONROE B. LEVOY,

Petitioner,

against

STYL-RITE OPTICAL CORPORATION,

Respondent.

MONROE B. LEVOY,

Petitioner,

against

IDEAL OPTICAL CO., INC.,

Respondent.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Statement

Petitioner seeks to review the decision of the Court of Appeals for the Second Circuit in a case in which he was the plaintiff and which decision held invalid Pat. No. Des. 147,368 granted to him for a spectacle frame.

Review by this Court is sought under paragraph (1), Section 1254 of Title 28, U. S. C., June 25, 1948, which consolidated Sections 346 and 347 of Title 28, U. S. C., 1940 Ed. Existing law is preserved by this revised section.

Rule 38 (2), Supreme Court Rules, provides that "only the questions specifically brought forward by the petitioner * * * will be considered."

Petitioner specifies three reasons on page 6 of his petition for granting this writ of certiorari. This brief, therefore, will be directed solely to establishing that none of these reasons are sufficient to move this Court's discretion to grant the petition.

Argument

Rule 38 (5), Supreme Court Rules, Title 28, Rules, points out that the review here sought is not a matter of right but solely within the sound judicial discretion of this Court.

No consideration here will be given to the four questions which are alleged on page 2 of the petition to be presented for review by this Court unless they relate to the three reasons specified by petitioner to warrant the grant of the writ.

To the same extent, no reply will be made to the five alleged errors committed by the Court of Appeals (p. 5, Petition).

The purpose of the statutes affecting certiorari was to curtail the Supreme Court's obligatory jurisdiction by substituting for the appeal as of right, discretionary review by certiorari in many classes of cases. *Ex parte Republic of Peru,* 318 U. S. 578, 87 L. Ed. 1014, 63 S. C. 793.

Review by certiorari by this Court has been sparingly exercised and then only in cases of peculiar gravity, which is not found here. This is a simple design patent, which has been held invalid by both the District and Circuit Courts.

In Reply to Petitioner's Reason 1 (Petition, p. 6) for granting the writ

It is contended that the decision of the Court of Appeals by its construction of Section 73, Title 35, U. S. C. (which statute is quoted on page 3 of the petition), nullifies the effect of that statute.

In the consideration of this petition, it should be noted that by Section 73, Title 35, in essence, Congress provided that a design patent was to be granted only to one who had *invented* a new, original and ornamental design. If there was no invention, a patent was not to be granted.

This statute further provided that the design should not have been described in a publication more than one year prior to the application for patent or should not have been publicly used or sold in this country for more than one year prior to the application for patent.

Thus, the particular statute sets up two conditions precedent for the grant of a design patent, first, there must be invention, and second, the design shall not have been described in a publication more than one year prior to the application for patent or on sale in this country more than one year prior to the application. The first condition that there must be invention should not be confused with the second condition that the design is not anticipated by publication or use.

Both the District Court (Opinion, Record, p. 267, fol. 800) and the Court of Appeals (which apparently found the District Court's opinion so clear and convincing that it adopted it in toto, Record, p. 285) found that invention was wanting.

Lack of invention could have been found, if the Court so chose and good reason for this appeared, without resort to the prior art although both the District Court and the Court of Appeals found that each element in the design patent in suit was known to designers in the field in almost similar surroundings so that petitioner was not an inventor.

At any event, the Courts below found without doubt that the patentee had not invented a new, original and ornamental design.

The Supreme Court ordinarily accepts the concurrent conclusion of the District Court and Court of Appeals that a patent is invalid. *Universal Oil Prod. Co.* v. *Globe Oil and Ref. Co.*, 322 U. S. 471, 88 L. Ed. 1399, 64 Sup. Ct. 1110.

Want of invention is primarily a question of fact which will not be revised by this Court on certiorari or set aside. *Leeds and Catlin Co.* v. *Victor Talking Mach. Co.*, 213 U. S. 301, 53 L. Ed. 805; 29 Sup. Ct. 495; *Goodyear Tire and Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 88 L. Ed. 721, 64 Sup. Ct. 593.

Therefore, petitioner's first reason for granting the writ must fall because both Courts properly applied the statute by finding that the patentee was not an inventor.

It is respectfully submitted that finding a patent invalid for want of invention is not a nullification of the statute but conversely applies the strict congressional requirement that invention must be found before a design patent is granted.

To sum up, even though a design is new, original and ornamental, it does not necessarily follow that a design patent is granted as a matter of right. Rather, the design must have that further or additional quality which removes it from the routineer or skilled craftsman into the realm of the inventor.

Failure to find invention does not nullify the design patent statute but gives life to it.

Whether or not the spectacle frame of the patent in suit involved inventive talent, a matter in which it is urged the Court of Appeals erred by Specification of Error 1, is a matter of fact concurred in by the two Courts below, which is not to be disturbed by granting the writ.

Certiorari is not granted because of an error of fact but only for some other compelling reason.

In Reply to Petitioner's Reason 2 (Petition, p. 6) for granting the writ

It is contended that "the decision of the Court of Appeals is in conflict with applicable decisions of this Court."

The decision of the Appellate Court is a per curiam decision affirming without comment the decision of the District Court on the opinion of the District Judge. In other words, the Appellate Court must have believed that nothing could be added to the opinion of the District Court.

Apparently, petitioner believes that the decision of the District Court and that of the Court of Appeals is in conflict with this Court's decision in *General Talking Pictures Corp.* v. *Western Electric Co., Inc.*, 304 U. S. 175, 82 L. Ed. 1273, 58 S. C. 840 (cited on page 11 of petitioner's brief).

This is not so because that case holds that a patentee may obtain a valid patent for an invention which is a continuation of or a division of an earlier filed pending application.

Here, the patent in suit (Exh. 1, Record, p. 244) was not a division of the Jeweled Specs Patent (Exh. J, Record, p. 249) nor was it a continuation thereof. As a matter of fact, no common subject matter is found in these two except that each is for a spectacle frame. The frames are of different shape and the element of design is different.

Nor is there any element of design common to the patent in suit, Exhibit 1, and the earlier filed patent for the Jeweled Specs, Exhibit J. The former had a contrasting design appearance instead of the jewels of the latter.

As an inspection of these two patents conclusively establishes, which the Courts below found to be a fact,

the plastic frame of the former is entirely different from the plastic frame of the Jeweled Specs Patent, Exhibit J.

A further inspection of the record shows that the frame of the Jeweled Specs which was sold and described in a printed publication more than one year prior to the application for the patent in suit (Record, p. 246, Exh. F) is completely different from the frame of the earlier co-pending design patent for Jeweled Specs (Record, p. 249, Exh. J) but is exactly the same as the frame of the patent in suit.

At the trial, petitioner conceded that the only difference between the spectacle frame of the patent in suit and the frames of the Jeweled Specs of the prior publication and of the prior public sale, resided in the substitution of a contrast for the jewels, the plastic frame of all three being exactly the same.

In view of the showing that a contrast was old in the Classic publication (Record, p. 252, Exh. L), the District Court and the Court of Appeals did not commit substantial error in additionally holding that the patent in suit was invalid in view of both the Jeweled Specs and the Classic publications.

This was a question of fact that is not contrary to the rule of the *General Talking Pictures Corp.* case, which does not apply and therefore properly was not considered by the Courts below, although cited by petitioner in the Court of Appeals.

The District Court and by reference, the Court of Appeals, contrary to petitioner's assertion as a matter of fact, did consider the cosmetic appeal alleged to flow from the spacing and shaping of the spectacle frame of the patent in suit (Record, p. 265). The District Court below found that such spacing and shaping added nothing to the design (Record, p. 265, particularly note 7). Surely, therefore, there is no conflict with *New York Belting and Packing Co.* v. *New Jersey Car Spring Co.*, 137 U. S. 445, 34 L. Ed. 741, cited on page 11 of the petition.

There is, therefore, no ground for granting this petition under Reason 2 since the decisions of the Courts below are not in conflict with any ruling of the Supreme Court.

In Reply to Petitioner's Reason 3 (Petition, p. 6) for granting the writ

It is apparently contended that the Court of Appeals has made it deceptively appear that 35 U. S. C. 73 offers protection for invention when, as a matter of fact, it does not. It is respectfully submitted that this is an unusual reason for granting the writ and makes it appear that the Court of Appeals by its decision is guilty of a deception on members of the public, namely, inventors.

There can be no denial that the design patent statute properly protects an inventor. It does not, nor should it, protect a routineer or for that matter, a highly skilled craftsman. If anyone below the status of an inventor should receive a monopoly, that is a matter for Congress and not for the Courts.

The law should be taken by the Courts as the Congress passed it and not as one member of the public, here, the petitioner, for his own benefit, so earnestly desires it to be construed.

Neither the statute nor the decisions of the Courts below are deceptive. The statute and these Courts by their decisions, have unmistakenly provided that a design patent should be granted only to an inventor and not to anyone else. That the Courts below found petitioner invented nothing is reason only for his disappointment that the lower Courts decided he was only a routineer or skilled craftsman and not one for granting this petition for writ of certiorari.

Conclusion

Wherefore, it is respectfully submitted that this petition for a writ of certiorari should not be granted.

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